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10/770,139	02/02/2004	John P. Downs	5398-CIP-CON-3	9662
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REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			NORDMEYER, PATRICIA L	
ART UNIT		PAPER NUMBER		1794
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/770,139

Filing Date: February 02, 2004

Appellant(s): DOWNS, JOHN P.

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Antonia M. Holland  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 28, 2008 appealing from the Office action mailed October 30, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

11/029,611 contains a related appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, 7, 9-14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey (3741786).

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12) having a transverse width, a row of adhesive segments (14) spaced apart along the longitudinal length of the tape and transversely in side-by-side relation, each segments being disposed between the two side edges, and can be transferred by flexing the tape. The adhesive is pressure sensitive adhesive (PSA) (col. 3, line 30) and applied to the carrier in a hot melt form, hence it includes hot melt adhesive. The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line as shown in figure-1. The segments can be of any shape such as dots, bars, star, triangle, etc. or any pattern without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. The transverse position of each segment is distinct as shown by their separate position along the

tape length. In col. 6, lines 32-37, Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segments is individually exposable and dispensable. Further, figure-1 shows that the each of the tape edge is at least equal to the adhesive segments. However, Torrey fails to teach that the adhesive segments are aligned in sided-by-side relation. It would have been obvious to one having ordinary skill in the art to modify Torrey by providing the adhesive segments as aligned in side-by-side relation at transversely separated locations, since such a modification would have involved a mere change in the pattern or design of the adhesive segments in the longitudinal segments of the carrier tape, as such a change in pattern provides for aesthetic appeal.

Regarding claims 3, 11, 20, Torrey, in col. 2, lines 8-22, teaches that the adhesive segments adhere less strongly to the second release surface than they do to the first release surface of the carrier tape.

The intended use phrases such as “to an abutting planar surface when the carrier tape is transversely flexed” have not been given any patentable weight because said phrases are not found to be of positive limitations.

For claim 5, Torrey clearly discusses that the shape of the adhesive segments are not critical and it can have any desired shape. Thus, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing its adhesive segments in a disc shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being with the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

For claim 9, see Torrey, figures 1 and 4, which shows that the adhesive segment are substantially linearly disposed along the length of the tape

Regarding claim 10, figure-4 of Torrey shows that the adhesive segments are located between the first and second edges of the carrier tape.

For claims 12, 13, the separation distance between the adhesive segments are obvious matter of design choice modification for optimizing the adhering properties.

#### **(10) Response to Argument**

Appellant argues that the Examiner has failed to provide a *prima facie* case of obviousness as Torrey fails to teach or suggest all the limitations of the present invention.

Appellants further argue that the statement “wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed” in claims 1, 7 and 16 and is functional language and not intended use.

Appellant also argues that Torrey does not teach or suggest adhesive segments arranged in aligned columns, in transversely separated location and that the adhesive segments are arranged in a side-by-side relation within the longitudinal section. Appellant argues that Torrey does not provide a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is at least equal to the largest transverse extent of an adhesive segment. Appellant further argues that Torrey does not further provide that each longitudinal section of the carrier tape contains the same number of adhesive segments.

In response to Appellant's argument that the Examiner has failed to provide a *prima facie* case of obviousness as Torrey fails to teach or suggest all the limitations of the present invention, Torrey teaches an adhesive dispensing tape (10) comprising a flexible carrier tape (12) having a transverse width, a row of adhesive segments (14) spaced apart along the longitudinal length of the tape and transversely in side-by-side relation, each segments being disposed between the two side edges, and can be transferred by flexing the tape, which is the claimed invention.

In response to Appellant's argument that the statement "wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed" in claims 1, 7 and 16 and is functional language and not intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Torrey also discloses that any portion of the adhesive may be dispensed (Column y, lines 32 – 33), which leads one of ordinary skill in the art that the segments can be individually exposable and dispensable.

In response to Appellant's argument that Torrey does not teach or suggest adhesive segments arranged in aligned columns, in transversely separated location and that the adhesive segments are arranged in a side-by-side relation within the longitudinal section, the adhesive segments provides for the functional properties of the tape, while the adhesive segments can be provided in a pattern, such as a side-by-side relation, for imparting aesthetic appeal, without

affecting the adhesive functional properties. MPEP 2144.04 (I) and (IV). Further, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice. (Column 3, lines 57 – 75).

In response to Appellant's argument that Torrey does not provide a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is at least equal to the largest transverse extent of an adhesive segment, Torrey discloses a margin extending between the outer edge and the adhesive segments (Column 5, lines 14 – 27). Further, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice. (Column 3, lines 57 – 75). It would have been an obvious matter of design choice to change the shape of the border, since a modification would have involved a mere change in size of the width of the border. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV)

In response to Appellant's argument that Torrey does not further provide that each longitudinal section of the carrier tape contains the same number of adhesive segments, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice. (Column 3, lines 57 – 75). Therefore, it would have been obvious to one of ordinary skill in the art to provide each longitudinal section of the tape with the same number of adhesive segments.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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